

### REMARKS

In view of the above amendments and the following remarks, reconsideration and further examination are requested.

Claims 33-38 were rejected under 35 U.S.C. § 251 as being improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the reissue application is based. The details of the allegedly recaptured subject matter are stated by the Examiner as follows:

“In this case, the omitted claim limitations in the reissue are the specifics of ‘an error ratio calculating means’ and ‘an automatic frequency correcting means’. These limitations were presented in the amendments filed on 1/11/96 to overcome the prior art rejections in view of Lawrence et al stated in the Office Action mailed on 07/06/95.” Outstanding Office Action, item 3, page 3.

In the application that matured into the original patent, originally filed claim 8 included recitations to the “error ratio calculating means” and “automatic frequency correcting means.” Originally filed claim 8 was rejected under 35 U.S.C. § 112, second paragraph, but was not rejected on the basis of prior art in the first Office Action, or otherwise.

In the January 8, 1996 Amendment filed in response to the first Office Action, claim 14 was added and included the features of original claim 8 including the “error ratio calculating means” and “automatic frequency correcting means.”

In the present reissue application, claim 33 includes the recitations of the added claim 14 discussed above, but omits the limitations of “error ratio calculating means” and “automatic frequency correcting means.” Claim 35 is a method claim similar to claim 33. Claim 37 differs from claim 33 in reciting an NTSC filter rather than a notch filter.

For there to be impermissible recapture, a two part test must be satisfied. The first prong of the test is that the claims in the reissue application must be broader than the patented claims. MPEP 1412.02, page 1400-13, column 1, last paragraph. As discussed above, the claims in the present reissue application are broader than the patented claims because of the omission of the limitations of “error ratio calculating means” and “automatic frequency correcting means.”

The second prong is that the broader aspects of the reissue claims must relate to surrendered subject matter. Id at page 1400-13, column 2. For an omitted limitation in a reissue claim to be related to surrendered subject matter, the omitted limitation must have been “originally presented/argued/stated in the original application to make the claims allowable over a rejection” made in the original application. Id.

The second prong of the two step test for recapture is not satisfied in this case. The limitations at issue were present in the claims as originally filed and were not presented, argued, or stated in the original application to make the claims allowable over a rejection. Claim 14 replaced claim 8, and was drafted in such a way as to overcome the rejection of claim 8 under 35 U.S.C. § 112, second paragraph. However, the limitations of “error ratio calculating means” and “automatic frequency correcting means” were not presented to overcome the rejection, or argued or stated as being the basis for overcoming the rejection under 35 U.S.C. § 112, second paragraph. Therefore, the “error ratio calculating means” and “automatic frequency correcting means” limitations are not related to surrendered subject matter.

The Examiner asserts that the limitations at issue were presented to overcome the prior art rejections in view of Lawrence, but this is incorrect because Lawrence was never applied to claim 8. Moreover, claim 8 was replaced by claim 14, which included the limitations of claim 8, but was drafted to overcome the rejection under 35 U.S.C. § 112, second paragraph. The limitations of “error ratio calculating means” and “automatic frequency correcting means” were not presented, argued, or stated as making the claim 14 allowable over a rejection. Thus, there is no basis in the prosecution history of the original application to conclude that these limitations are related to surrendered subject matter.

Thus, the Examiner correctly states that the present reissue claims 33-38 are broadened via the omission of the limitations of “error ratio calculating means” and “automatic frequency correcting means,” thereby satisfying the first step of the two step test for recapture. But the Examiner has not shown that the omitted limitations are related to surrendered subject matter. Accordingly, the rejection of claims 33-38 based on recapture is incorrect and should be withdrawn.

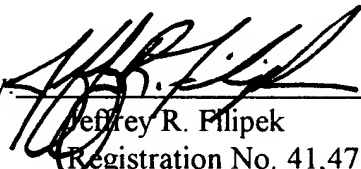
In view of the above remarks regarding claims 33-38, and the indication of the allowance of remaining claims 29-32 in item 4 of the Office Action, it is submitted that the application is condition for allowance.

The Examiner is invited to contact the undersigned attorney by telephone to resolve any remaining issues.

Respectfully submitted,

Mitsuaki OSHIMA et al.

By

  
\_\_\_\_\_  
Jeffrey R. Plipek  
Registration No. 41,471  
Attorney for Patentees

JRF/fs  
Washington, D.C. 20006-1021  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
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FIG. 2

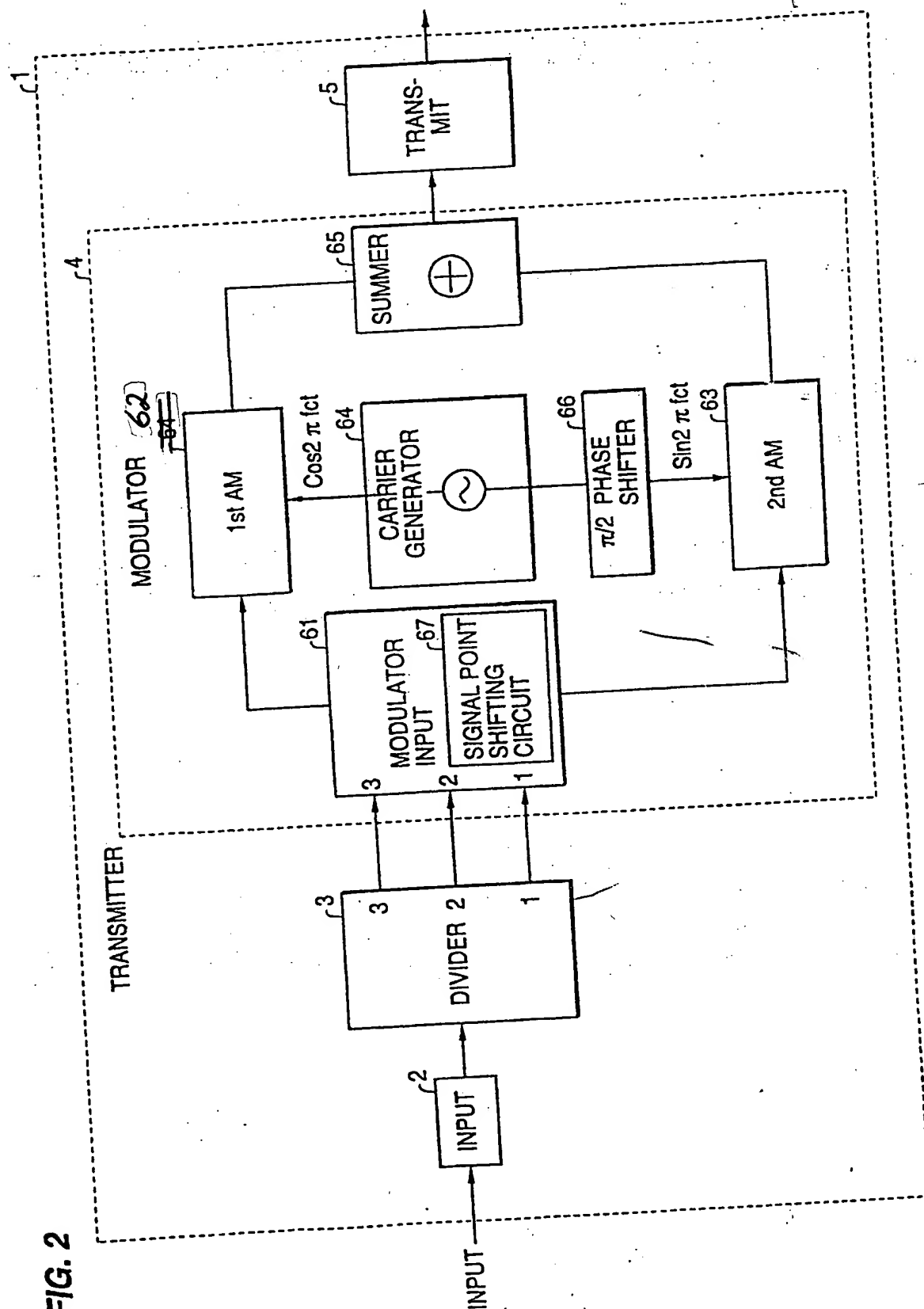


FIG. 10

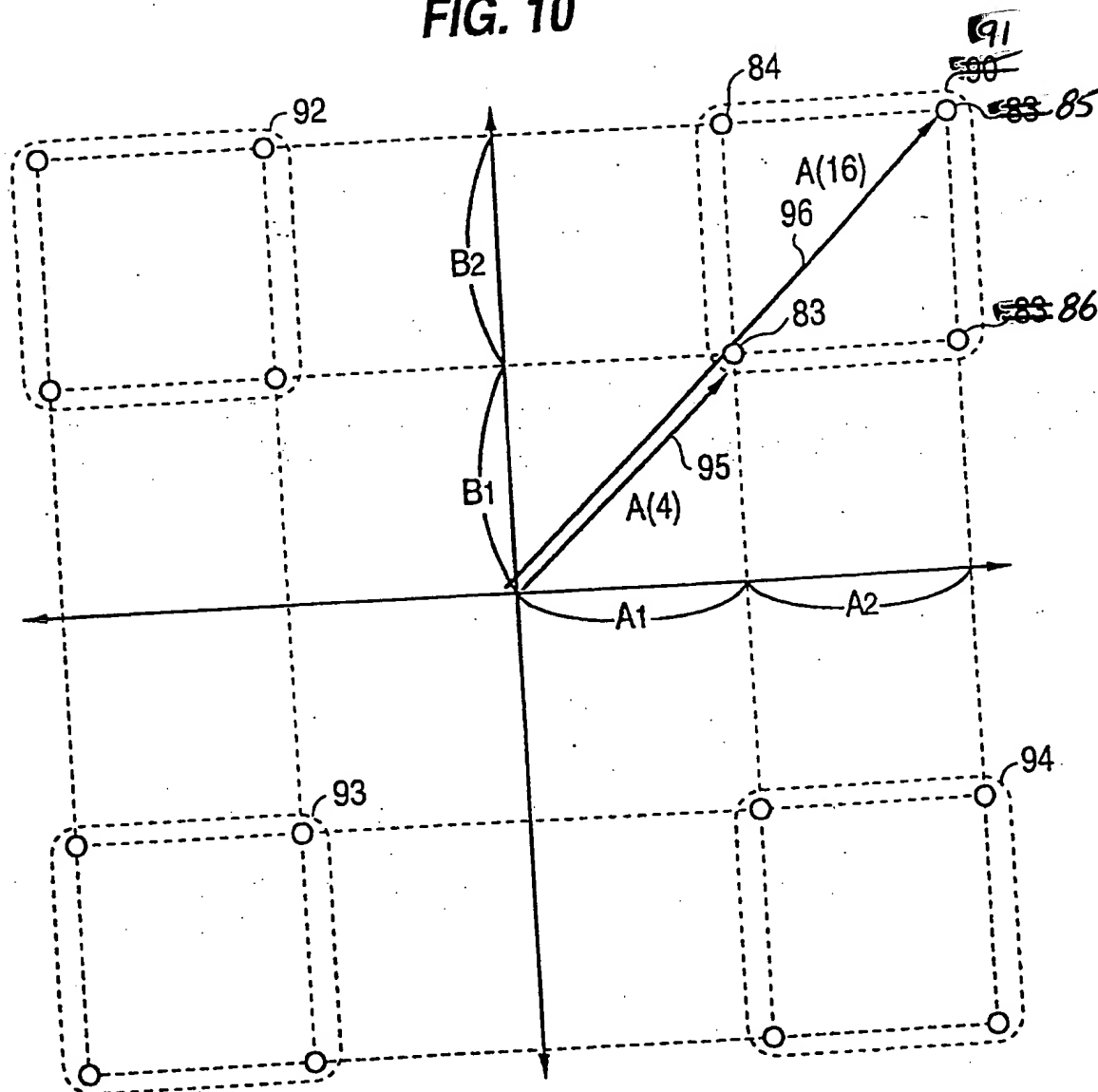
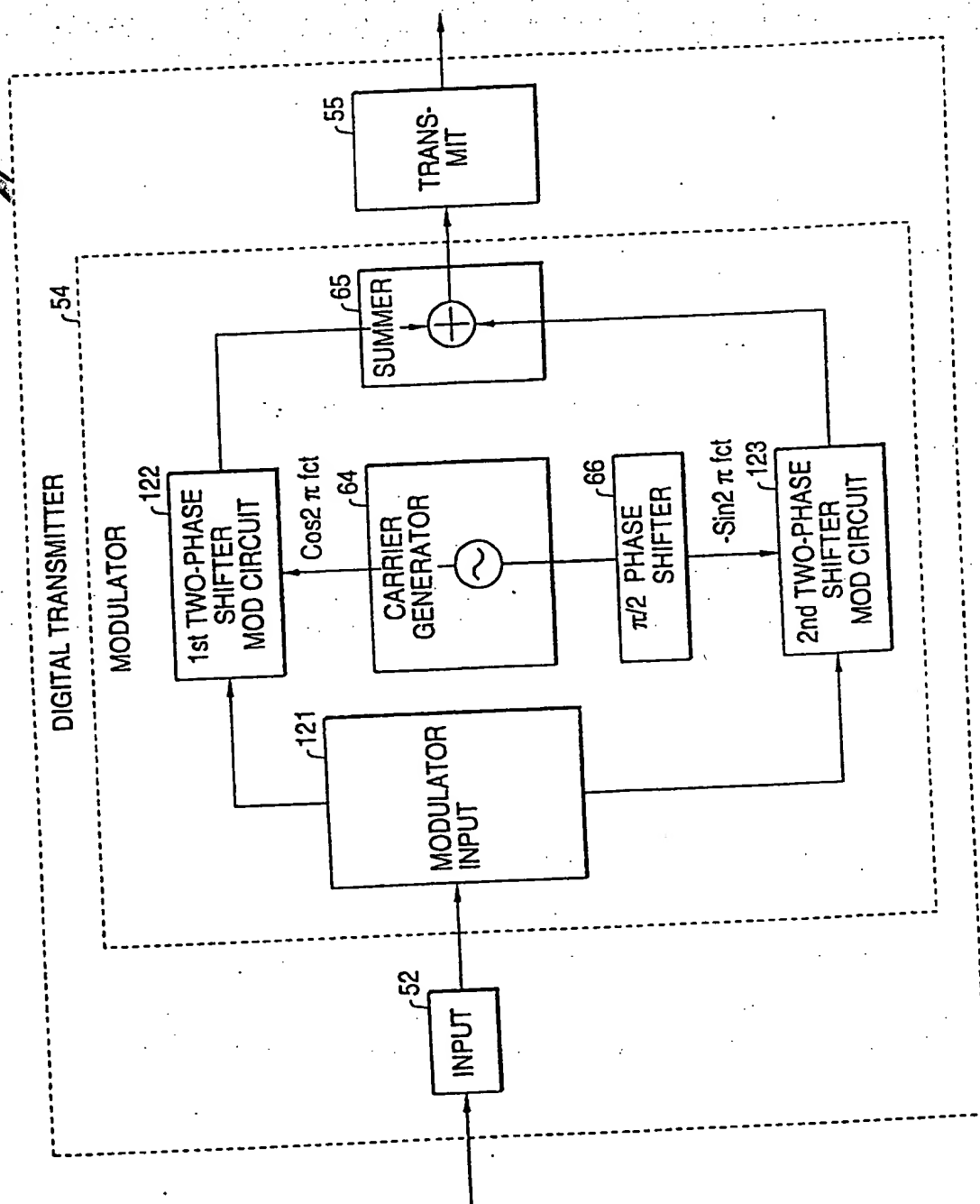


FIG. 17



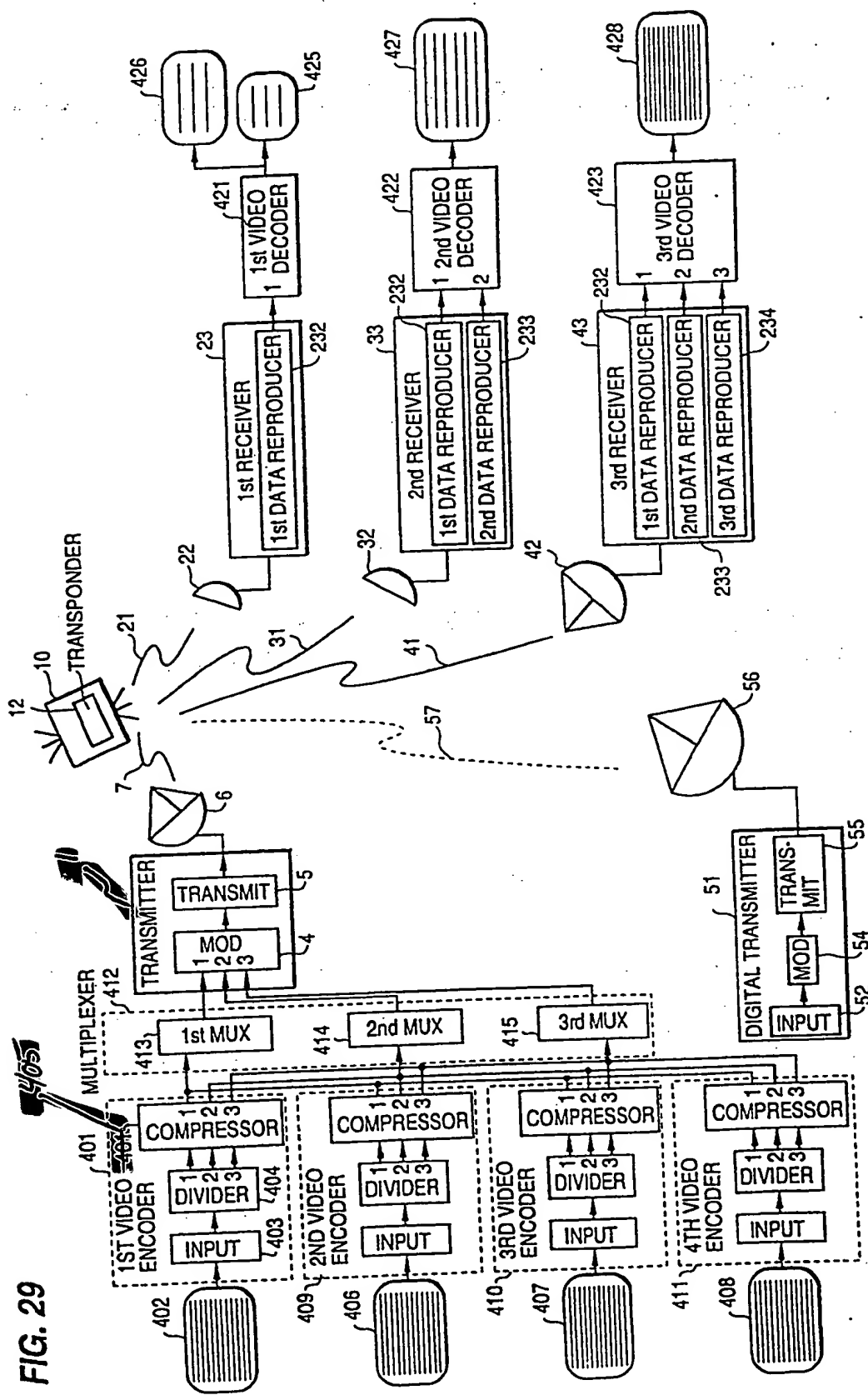


FIG. 48

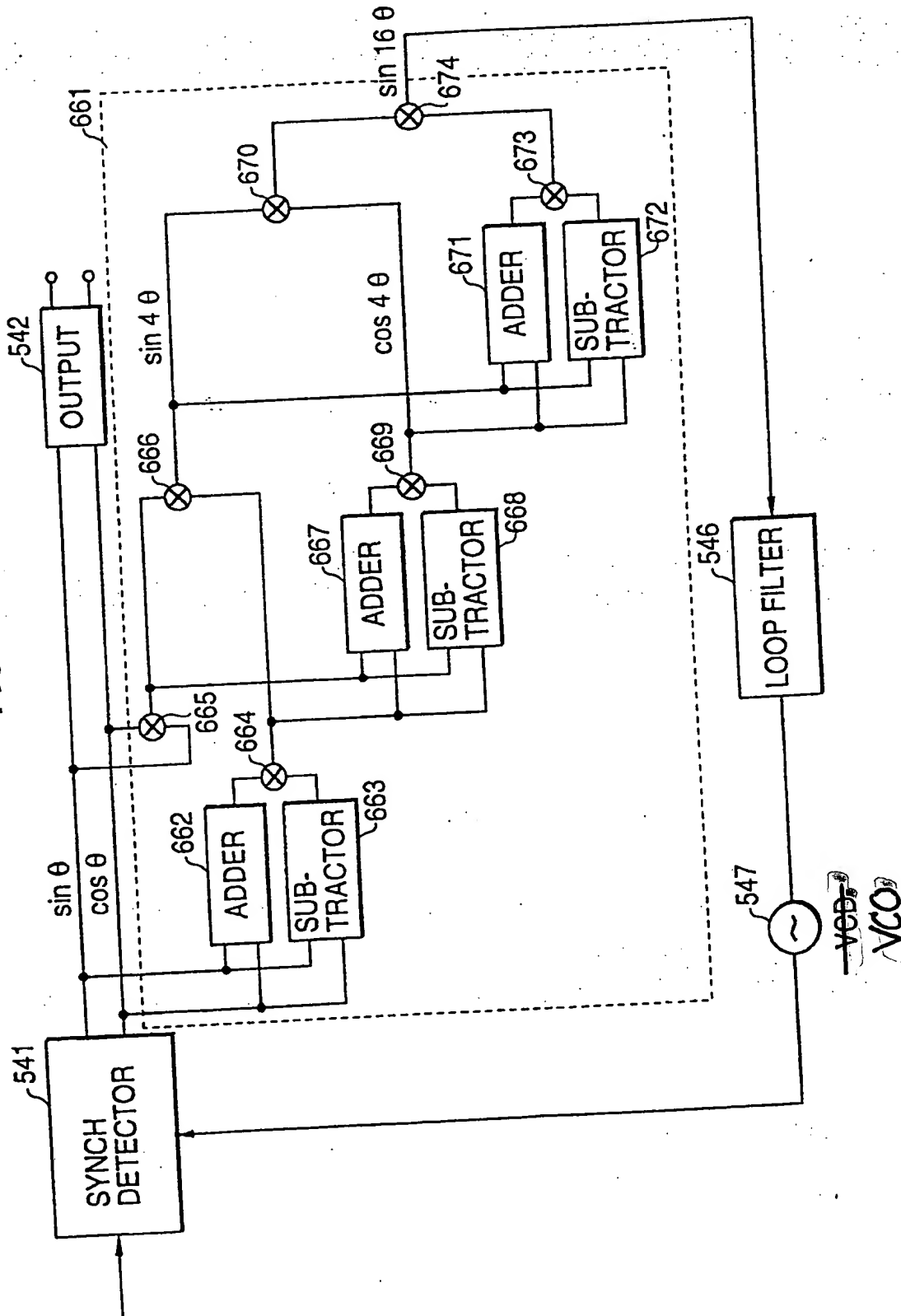
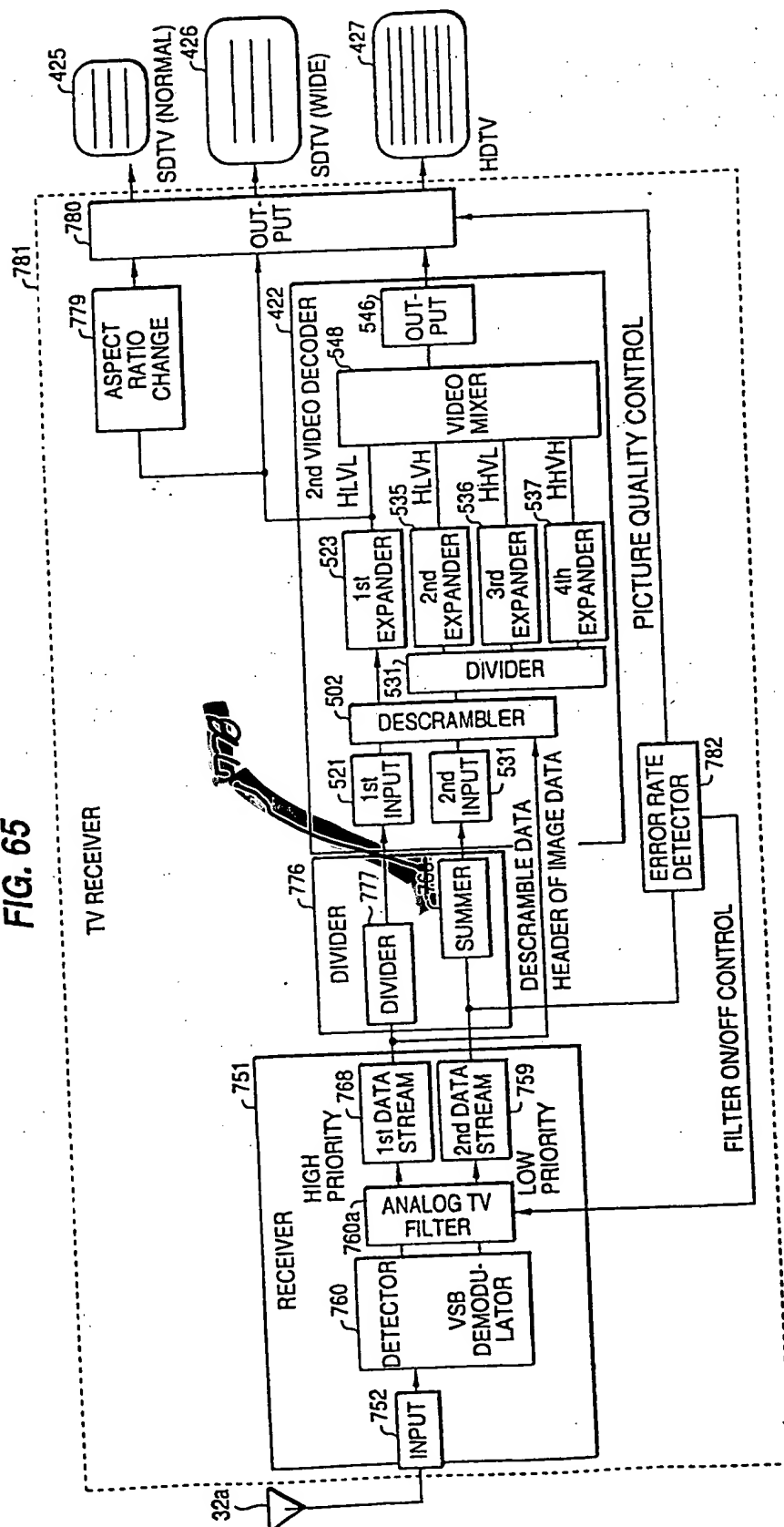




FIG. 65



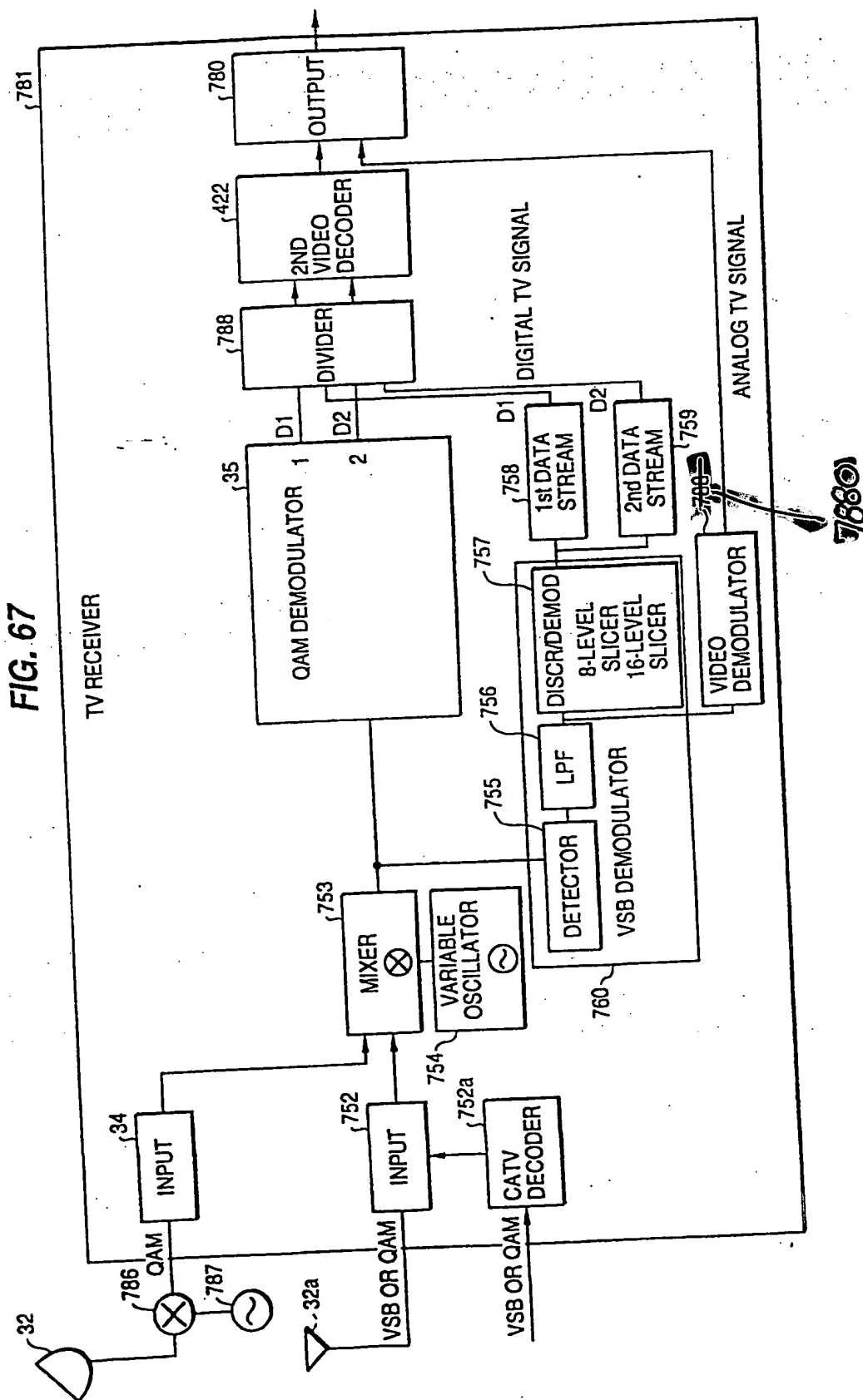


FIG. 93

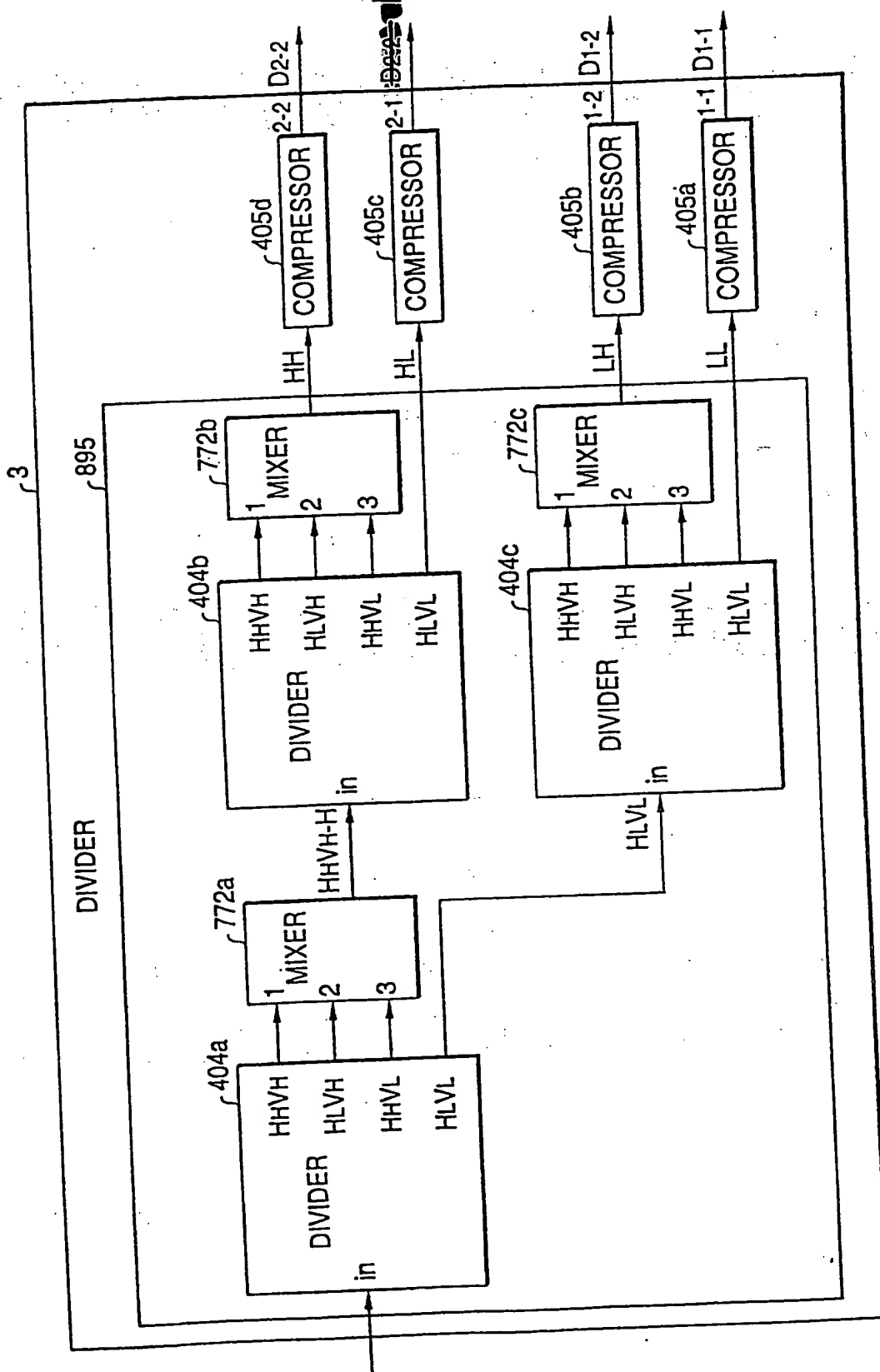
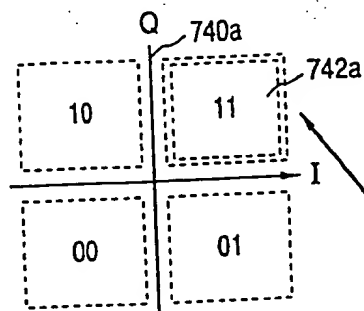
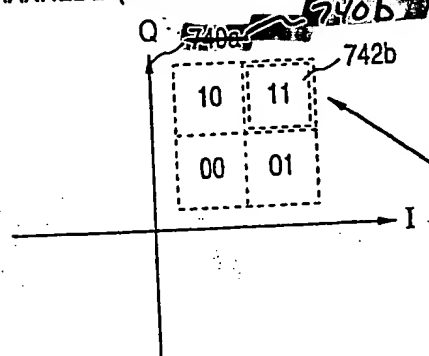


FIG. 112

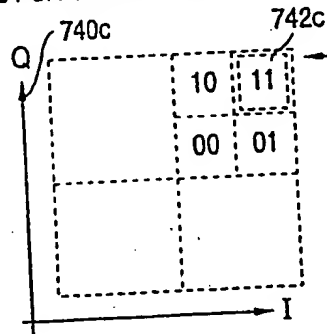
SUBCHANNEL-1 (SRQAM:D1 = 2bit)



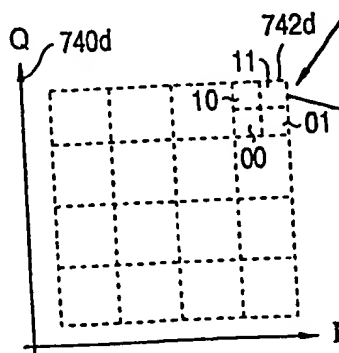
SUBCHANNEL-2 (16-SRQAM:D2 = 2bit)



SUBCHANNEL-3 (64-SRQAM:D3 = 2bit)



SUBCHANNEL-4 (256-SRQAM:D4 = 2bit)



CODE WORD-1

CODE WORD-2

CODE WORD-3

CODE WORD-4

741a 11 2bit  
741b

11 2bit

741c 11 2bit

741d 11 2bit

8bit

SIGNAL POINT  
CODE WORD  
11 11 11 11

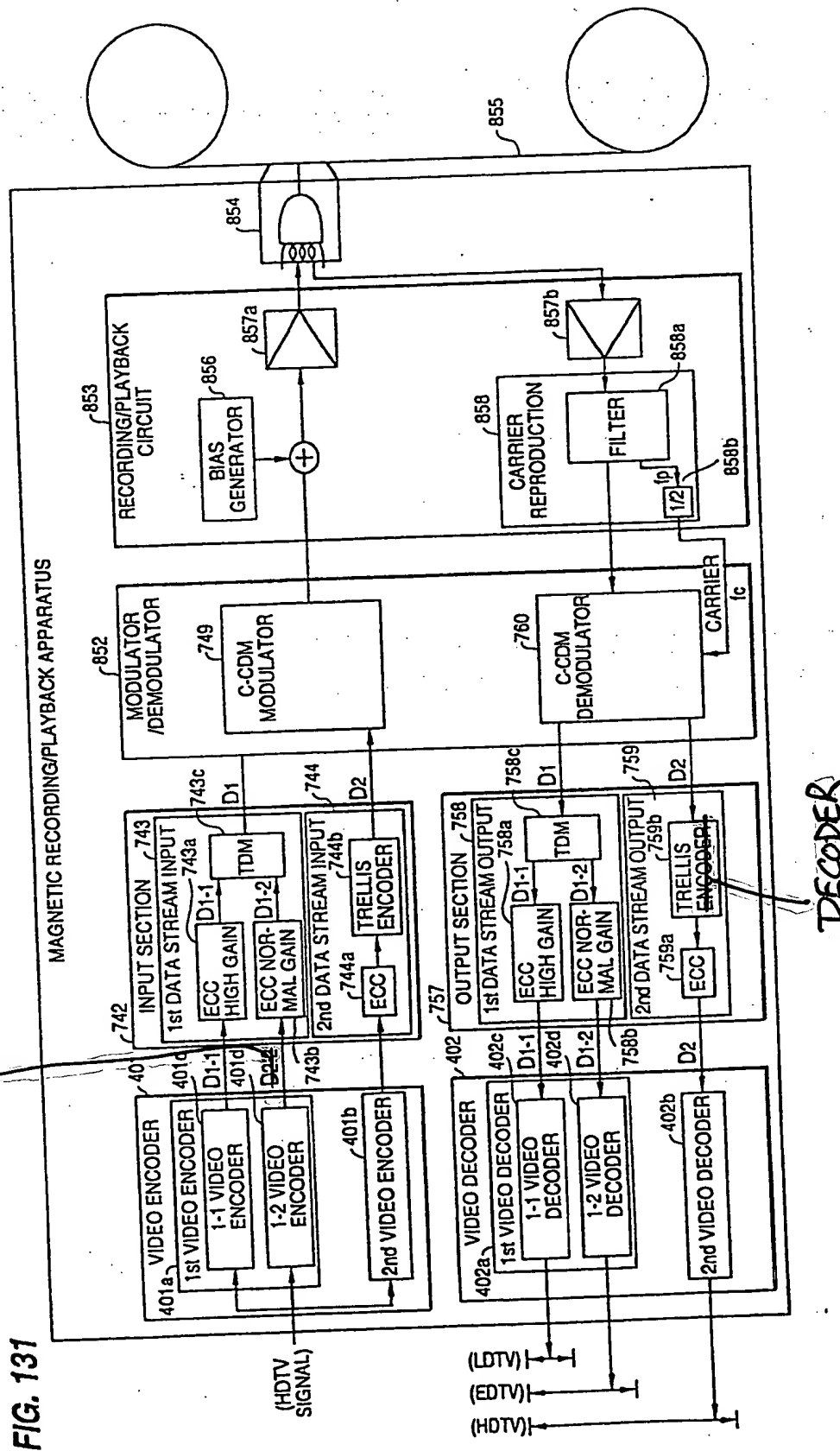


FIG. 138

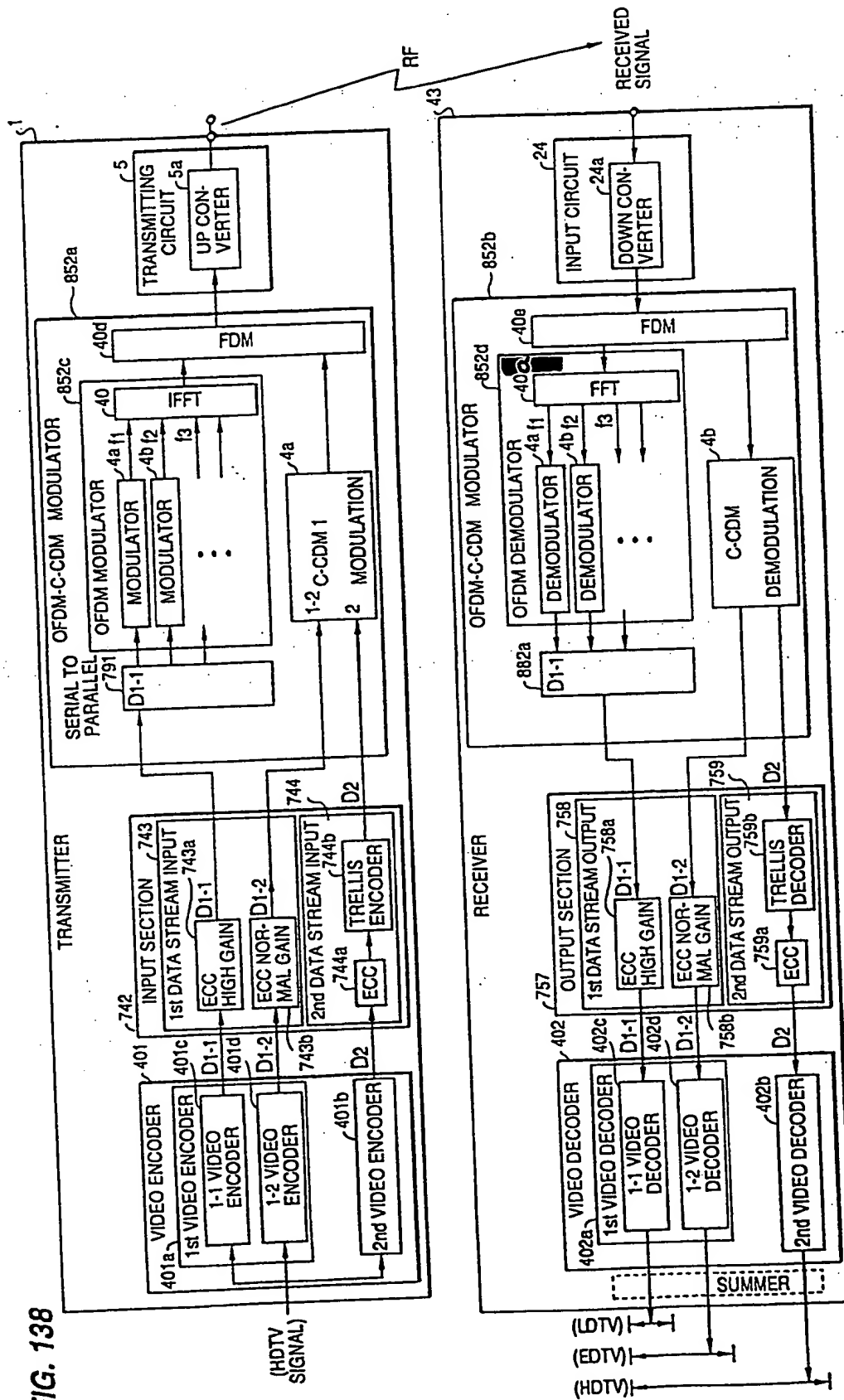


FIG. 144

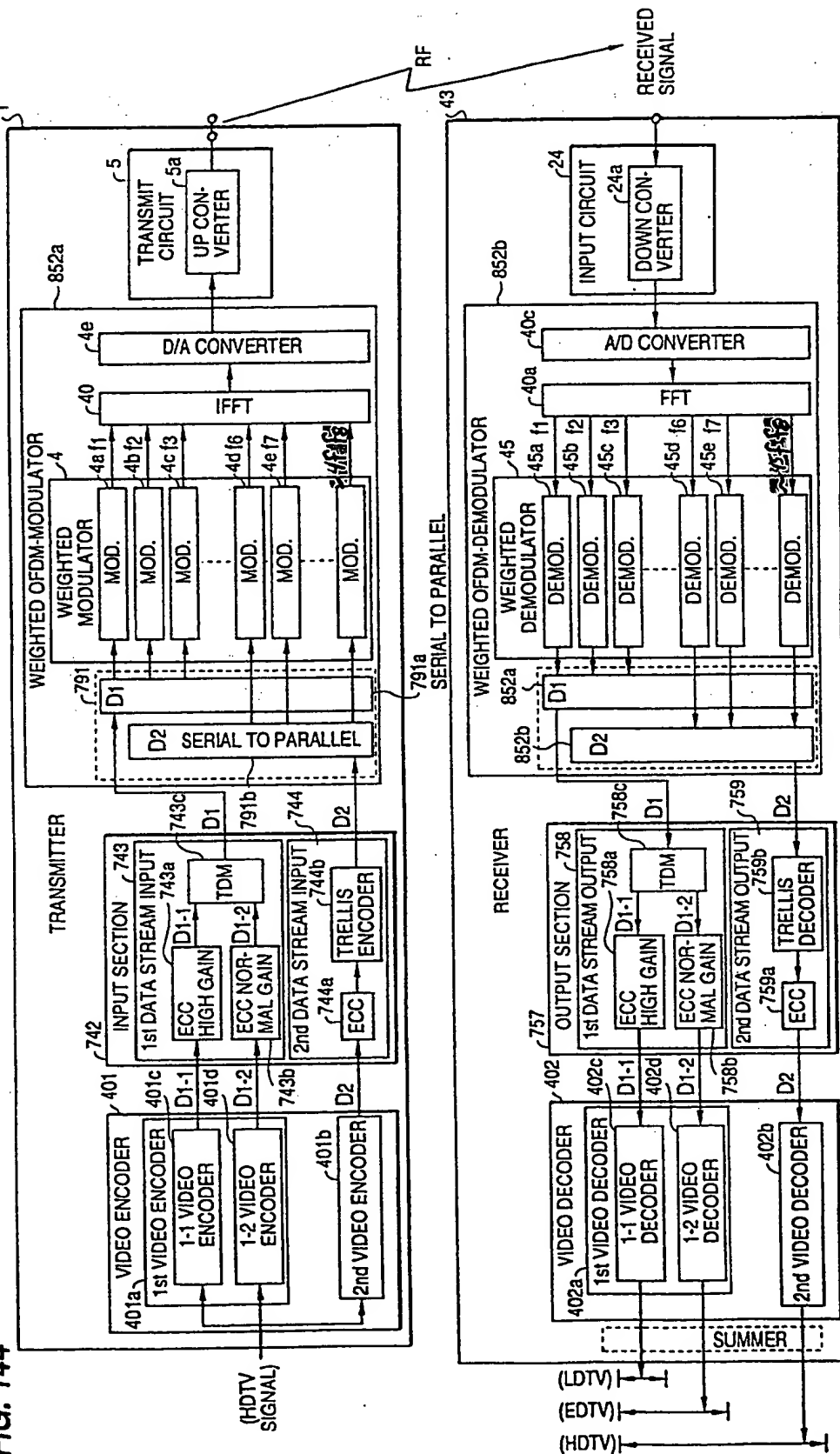


FIG. 169

